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Response to Office Action mailed February 10, 2004

Response transmitted Friday, April 9, 2004

REMARKS

1. Claims 1-20 are pending in the application. The Office Action has rejected Claims 1, 3-7, 9-13, and 15-19 under 35 U.S.C. § 102(b), and has rejected Claims 2, 8, 14, and 20 under 35 U.S.C. § 103(a). The Examiner is thanked for withdrawing the previous rejections of Claims 2, 8, and 14 under 35 U.S.C. 102(b). New Claims 21-24 have been added. No new matter was added in adding claims to the application.

2. Applicants thank Examiner Nguyen for the courtesy of a telephonic interview on March 23, 2004, between the undersigned, Examiner Nguyen, and Examiner William Bashore. We discussed primarily Claim 1. Examiner Bashore maintained that the steps of Claim 1 could be anticipated by Eduard Kitain, U.S. Pat. No. 5,864,871. Examiner Bashore stated that Kitain discloses a person sitting down at a computer and calling up a database of information concerning the stock market. The database will thus include information on a great number of companies, and also a number of industries. When the person enters or chooses a company, that is the "client." As shown in Kitain on Fig. 3, the database also discloses a list of industries, and thus the "client" is associated with the industries. Thus, goes the argument, the first two steps of Claim 1 are disclosed. Discussion focused on these points of Claim 1, and agreement was not reached.

3. The Office Action rejects Claims 1, 3-7, 9-13, and 15-19 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 5,864,871 to Eduard Kitain. Applicants traverse the rejections. The invention recited in Claim 1 is for a method of developing a dossier. The dossier concerns a client and one or more industries associated with the client. The rejection of Claim 1 cites unrelated teachings from many portions of Kitain, exaggerating the teachings of Kitain and using hindsight to re-create the invention. It is improper to use a mosaic of unrelated prior art to reject claims. *Panduit Corp. v. Dennison Mfg. Co.*, 227 U.S.P.Q. 337,345 (Fed. Cir. 1985) (reversing a lower court's finding of obviousness, and stating that it is improper to use a claim as a frame, taking individual parts of separate prior art references as a mosaic to create a facsimile of the claimed invention).

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Claim 1

The second step of Claim 1 is "presenting a list consisting of industries associated with the client." This is not a list of random industries, or a list of all industries, as in Kitain, but rather a list of industries associated specifically with the client whose name was received in the previous step. As described in the specification, these industries are already associated with the client and stored in the information repositories. See specification, p. 36, lines 6-9. This step is not described or suggested in Kitain. This step includes the phrase "consisting of," which limits the contents of the list only to industries associated with the client, and includes no industry not associated with the client. M.P.E.P. 2111.03 ("the transitional phrase 'consisting of' excludes any element, step, or ingredient not specified in the claim").

The rejection cites Kitain, col. 21, lines 36-38; col. 39, line 39, to col. 40, line 19; and Fig. 3, for the step of "presenting a list of industries associated with the client." The passages and Fig. 3 teach lists of "industries that the user may choose as selection criteria for documents, instead of contributors," such as industry groups. Col. 39, lines 41-43, and col. 40, lines 14-19 (emphasis added). These passages do not describe or suggest a list "consisting of industries associated with the client," but rather simply state that the user may select industries or industry groups. Kitain is silent as to whether or not the industries may be associated with a specific company. Indeed, Kitain teaches away from this step by teaching the "second query is for a list of all industries," which necessarily includes those not "associated with the client." Col. 16, lines 16-17 (emphasis added). Kitain does not disclose or suggest this step, limiting the list to only "associated industries" as recited in Claim 1. The rejection therefore does not make out a prima facie case for anticipation of Claim 1 by Kitain.

Claim 1 has been broadened by deleting the requirement that the name of a client be relevant to a proposal. Support for the amendment is found at least in the specification at p. 4, lines 4-5 and also at p. 36, lines 4-5.

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Claims 3-6 and 19

Claims 3-6 and 19 depend on Claim 1 or on claims depending from Claim 1 and are allowable at least because Claim 1 is allowable. The Examiner is respectfully requested to withdraw the rejection of Claims 3-6 and 19.

Claims 7 and 13

Claims 7 and 13 are similar to Claim 1, but claim a computer program embodied on a computer readable medium for developing a dossier, and a system for developing a dossier. The arguments against the rejections are very similar to the arguments given above for the method Claim 1. Claims 7 and 13 have been broadened in a manner similar to Claim 1. Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 7 and 13.

Claims 9-12 and 15-18

Claims 9-12 and 15-18 depend on Claim 7 or Claim 13 and are allowable at least because Claims 7 and 13 are allowable. The Examiner is respectfully requested to withdraw the rejection of Claims 9-12 and 15-18.

4. The Office Action rejects Claims 2, 8 and 14 as being unpatentable over U.S. Pat. No. 5,864,871 to Eduard Kitain in view of U.S. Pat. No. 6,327,588 to Mohamed Danish et al. ("Danish") under 35 U.S.C. § 103(a). The rejection admits that Kitain does not teach the step of "presenting an alternate list of industries not associated with the client," and states that Danish does teach this step, disclosing "a list box 15 comprising alphabetical listbox entries," and citing Danish col. 5, lines 62 to col. 6, line 10. Applicants traverse the rejections.

The cited passage concerns a search using a list box containing both industry standard terms and proprietary terms for product families, and refers to Fig. 2. Danish, col. 5, lines 65-66. Fig. 2 clearly shows a list of parts, including connectors, terminals, and tabs (emphases added). These may be industry standard terms for product families, but they do not describe or suggest the claimed step of "presenting an

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alternate list consisting of industries not associated with the client." Lists of parts, industry standard terms, and product families are not lists of industries, and are not "an alternate list of industries not associated with the client" as claimed in Claims 2, 8, and 14. Moreover, Danish does not even teach or suggest a first list box containing parts associated with something, and then an alternate list containing parts NOT associated with that something. Applicants submit that Danish does not suggest this limitation of Claims 2, 8, and 14.

As noted above, Kitain teaches a list of all industries, and does not teach lists of industries associated with or not associated with the client. Kitain, col. 16, lines 16-17. Adding Danish as a reference does not cure this defect. Danish does not describe or suggest a list of industries not associated with a client, and thus does not make obvious Claims 2, 8 and 14. In addition, Claims 2, 8 and 14 are allowable because they depend from Claims 1, 7, and 13, which are allowable. The Examiner is respectfully requested to withdraw the rejection of Claims 2, 8, and 14.

5. Claim 20 is rejected as unpatentable over U.S. Pat. No. 5,864,871 to Eduard Kitain in view of U.S. Pat. No. 6,240,410 to Kelly Wical et al. ("Wical") under 35 U.S.C. § 103(a). Claim 20 is allowable at least because it depends from Claim 4 which is allowable. Claim 4 recites that the dossier is arranged in sections according to people, documents, and projects; Claim 20, depending from Claim 4, adds the limitation that the section includes displayed expandable nodes and subnodes. Wical concerns a hierarchical data structure, but does not concern a dossier or sections on people, documents, or projects. The Examiner is respectfully requested to withdraw the rejection of Claim 20.

6. Applicants submit that the original and amended claims as presented above are allowable. Applicants have also prepared additional claims that further define the subject matter of the present application, with terms that have already been searched. Claim 21 recites the method of Claim 1, wherein the list of associated industries is presented in response to receiving the name of the client. Support for new Claim 21 is

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found at least in the claims as filed, in Figs. 20-23, and in the specification at p. 36, lines 4-6, and p. 37, lines 9-14. Claim 22 recites the method of Claim 1, "further comprising storing the association of one or more industries with the name of the client." Support for new Claim 22 is found at least in the claims as filed, in Figs. 18-23, and in the specification, at least at p. 32, lines 5-11, on p. 36, lines 6-9, and on p. 38, lines 14-16. New claims 23 and 24 are similar to Claims 21 and 22, and find support in the same areas of the application.

New Claims 21-24 are allowable because Claims 1 and 2, from which Claims 21-24 depend, are also allowable. In addition, at least Claims 21 and 23 are patentable because Kitain fails to disclose or suggest that the list of industries is presented in response to receiving the name of the client; Claims 22 and 24 are also patentable because Kitain fails to disclose or suggest that specific industries have stored associations with a specific client.

7. Applicants have amended claims, added claims, and have argued against the rejections. Applicants have shown that the references do not anticipate or make obvious the claims of the invention because the references do not disclose all the limitations of the claims. Applicants respectfully request the Examiner to enter the amendment, to reconsider the application, to withdraw the rejections and to grant allowance of this application. The Examiner is invited to contact the undersigned attorney for the Applicant via telephone if such communication would expedite this application.

Respectfully submitted,

 Apr 9, 2004

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